

28 SEP 2006

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MINNEAPOLIS MN 55440-1022

In re Application of	:	DECISION ON
SHUSTER et al	:	
PCT No.: PCT/US03/038685	:	
Application No: 10/537,741	:	
Int. Filing Date: 04 December 2003	:	PETITION UNDER
Priority Date: 04 December 2002	:	
Attorney's Docket No.: 14848-010US1	:	
For: Methods and Materials for Modulating TRPM2	:	37 CFR 1.47(a)

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 24 April 2006. The petition fee of \$200.00 has been paid in full because \$70.00 has been charged to petitioner's Deposit Account No. 06-1050, which is the amount petitioner was deficient.

**BACKGROUND**

On 04 December 2003, petitioner filed international application PCT/US03/038685, which claimed priority to an earlier application filed 04 December 2002.

On 03 June 2005, petitioner filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, *inter alia*, the U.S. basic national fee. No executed declaration or oath accompanied the above papers.

On 24 October 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" must be submitted within two months from the date of mailing or 32 months from the priority date for the application, whichever is later in order to avoid abandonment of the national stage application.

On 24 April 2006, petitioner filed, *inter alia*, the present petition in support of filing an executed Declaration without the signatures of Ulf N.G. Arvidsson.

## DISCUSSION

### PETITION UNDER 37 CFR 1.47(a):

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

### INVENTOR CANNOT BE REACHED:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under **37 CFR 1.47**, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under **37 CFR 1.47**.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner has satisfied requirements (1), (2), (3) and (4) under 37 CFR 1.47(a).

Regarding requirement (1), petitioner has provided the fee under 37 CFR 1.17(g).

Regarding requirement (2) the statements of Angela Parsons are sufficient to show diligent effort to locate non-signing inventor Ulf Arvidsson because an internet search was conducted but was unsuccessful in terms of discovering any new relevant address information about the non-signing inventor.

Accordingly, the actions enumerated by submitted statements are sufficient to establish that the non-signing inventor could not be found or reached after diligent effort.

Regarding requirement (3), petitioner has provided a statement of the last known address of the missing inventor.

Gardstigen 4  
Lidingo, Sweden

Regarding requirement 4, petitioner has provided an executed declaration signed by Smauel J. Shuster, Laura S. Stone, Hong-Yan Zhang, and Lucy Vulchanova on their behalf and on the behalf of the nonsigning joint inventor Ulf N.G. Arvidsson.

Petitioner has satisfied items (1), (2), (3), and (4) under 37 CFR 1.47(a), thus completing the requirements under 37 CFR 1.47(a).

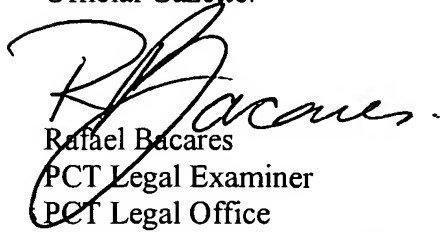
### **CONCLUSION**

The petition under 37 CFR 1.47(a) is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The application will be given a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **24 April 2006**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.



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Ulf N.G. Arvidsson  
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In re Application of  
SHUSTER et al  
PCT No.: PCT/US03/038685  
Application No: 10/537,741  
Int. Filing Date: 04 December 2003  
Priority Date: 04 December 2002  
Attorney's Docket No.: 14848-010US1  
For: Methods and Materials for Modulating TRPM2

Dear Mr. Arvidsson:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

  
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